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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,125	01/29/2004	Jean-Laurent Luquet	945-011672-US (PAR)	4365
2512	7590	11/27/2006	EXAMINER KOHNER, MATTHEW J	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			ART UNIT 3653	PAPER NUMBER

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/767,125

Applicant(s)

LUQUET ET AL.

Examiner

Matthew J. Kohner

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "for receiving the mail items ejected through an exit slot of a folding and inserting machine" in lines 1-3. It is unclear whether the Applicant is claiming the tray in combination with the folding and inserting machine or rather that the folding and inserting machine is merely an intended use. Examiner would interpret the above language as merely an intended use and not a structural limitation, yet the Applicant has claimed the feet of the machine as cooperating with the hooking means of the tray. Therefore, the scope of the above language it is unclear.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-3, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,155,643 to Ladds et al. (hereinafter Ladds) in view of US Patent No. 2,963,761 to Haydock (hereinafter "Haydock").

In regard to claims 1 and 2, Ladds discloses a mail item receiving device for receiving the mail items ejected through an exit slot of a folding and inserting machine, comprising a support plate (52/54) on which the ejected mail items will accumulate, a front wall (38/40) on which these mail items will abut upon their ejection, two lateral walls (48,50) and said support plate comprising two hollows (see Fig. 4) made on either side of its longitudinal axis at the level of its join with said front wall, wherein each hollow creates an opening between a respective lateral wall and the front wall and said rear wall comprises hooking means (36).

Ladds does not specifically disclose a rear wall intended to align these mail items once they have fallen on the support plate. However, it is clear from Figure 3 that the machine itself acts as the rear wall (see portion of machine below 58 in Fig. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added a rear wall to the tray for the purpose of keeping the mail items from falling out.

Further, Ladds does not disclose the hooking means which cooperate with the feet of the machine for connecting the receiving device to the folding and inserting machine. However it is recognized in the connecting art that clips are equivalent to the hooking means disclosed by Ladds. Haydock disclose a clip attached to a tray with the purpose of securing a rod shaped object (see Fig. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ladds to include clip

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as taught by Haydock for the purpose of attaching the tray to cylindrical legs since Haydock's clips would provide a more secure attachment.

In regard to claims 3 and 8, Ladds discloses an outer corner of the lateral wall without a rounded edge.

In regard to claim 7, see Fig. 4.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,155,643 to Ladds in view of Haydock and further in view of US Patent No. 5,018,623 to Hrenyo (hereinafter "Hrenyo").

In regard to claim 4, Ladds does not disclose reinforcing ribs. However, it is well known in the art that trays can include reinforcing ribs to strengthen the trays. Hrenyo discloses such a tray (26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ladds include a tray with reinforcing ribs, as taught by Hrenyo, since the ribs would strengthen the tray.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,155,643 to Ladds in view of Haydock and further in view of US Patent No. 5,454,553 to Firl et al. (hereinafter "Firl").

In regard to claim 5, Ladds does not specifically disclose the material from which the tray is made. However, it is well known in the art that input and output trays are made from molded plastic. Firl discloses such a tray (col. 2, lines 65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ladds include a tray made of molded plastic, as taught by Firl, since the trays

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could be produced via a inexpensive manufacturing process and further be a lightweight material.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,155,643 to Ladds in view of Haydock and further in view of Japanese Patent No. 8-337349 assigned to Ricoh (hereinafter "Rico").

In regard to claim 6, Ladds does not disclose a transparent material from which the tray is manufactured. However, it is well known in the art that trays can be manufactured from transparent material. Ricoh discloses such a tray (see abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Ladds include a tray manufactured from transparent material, as taught by Ricoh, since it would improve visibility of the mail.

Response to Amendment

Applicant has amended claim 1 to include a second recitation of "a mail item receiving device" in the preamble of the claim. This does not overcome the 112 rejection. If applicant wishes to claim the receiving device in combination with a mail folding and inserting machine, then a mail folding and inserting machine must be positively recited in the body of the claim. As recited in the preamble, it appears to be merely is an intended use.

Applicant's amendment to claim 1 has overcome the antecedent basis rejection raised in the previous action.

Response to Arguments

Applicant's arguments filed September 18, 2006 have been fully considered but they are not persuasive.

Applicant has argued that the rear wall as claimed in claim 1 is intended to align the mail items. Applicant argues that since the tray in Ladds is angled downward, it would not have been obvious to add a rear wall to the tray of Ladds to align the mail items. However, the intended use of a structure is not given patentable weight.

Therefore, the fact that Applicant has claimed that the rear wall is "intended to align these mail items" is inconsequential as long as a rear wall in Ladds is capable of performing that function. Here the rear wall would be capable of performing that function since a person picking up mail items would reach into slot 42 to push the mail items back against the rear wall to align them before removing them from the tray.

Applicant has argued that there is no reason to add a rear wall to the tray. Examiner disagrees. Paper processing machines do not necessarily have flat edges. For example, many paper processing machines have curved surfaces and a tray such as Ladds would not fit entirely flush to the side. Therefore, as described above, when a person picking up mail items reaches into slot 42 to push the mail items against the back to align them, if the machine has a curved surface, the papers would not be aligned. Therefore, a rear wall with a straight profile would have to be added to ensure proper alignment of mail items before removal.

Applicant has argued that "When 'the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference' *In re Rigckaert*, 28 USPQ2d 1955, 1057 (Fed. Cir.

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1993).” Applicant’s remarks, page 7. However, Examiner notes that the Federal Circuit has clarified that the suggestion to combine does not need to come from the art itself.

“[T]here is no requirement that the prior art contain an express suggestion to combine known elements to achieve the claimed invention. Rather, the suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art.”

Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472 (Fed. Cir. 1997).

Therefore, Examiner relies on the motivation to combine which has been provided in the previous rejection.

Applicant has argued that the references Haydock and Ladds are in non-analogous arts. Examiner submits that the art in question here is in the field of attaching devices. Whether it is a clip means, a hooking means, screw, etc., devices that would provide insight on how to attach and detach would be considered within the art.

Applicant has argued that the references Hrenyo and Ladds are in non-analogous arts. Examiner submits that the art in question here is in the field of plastic containers. It is very well known that adding ribs will reinforce a plastic structure.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kohner whose telephone number is 571-272-6939. The examiner can normally be reached on Mon-Fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew J. Kohner
Examiner
Art Unit 3653

mjk


PATRICK MACKEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600